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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,451

03/24/2006

Johannes Panten

51012

9274

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7590

11/25/2008

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EXAMINER

GRESO, AARON J

ART UNIT

PAPER NUMBER

4131

MAIL DATE

DELIVERY MODE

11/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/573,451

**Applicant(s)**

PANTEN ET AL.

**Examiner**

AARON GRESO

**Art Unit**

4131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)  
Paper No(s)/Mail Date 3/24/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Objections***

#### ***Specification/Disclosure***

The specification is objected to because of the following informalities: The Specification of the application (Fifth Paragraph after "Use of 3-Cyclohexenyl-1-Propanol as a Fragrance") contains references to Claims 1, 4 and 8. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Nordstrom* (US 3536687).

*Nordstrom* teaches a method of making a polymer by mixing a monomer (Compound I) with various other compounds (i.e., the composition of instant Claim 1) prior to polymerization. See the Abstract, and Column 2, Lines 1-17 and Example 2.

*Nordstrom* discloses a genus identified as compound I which encompasses the species recited in the present claims. See col. 2, lines 1-17. When R is a chain of 3

alkylene carbon atoms, and R2- R5 are hydrogens, the genus includes 3-cyclohexenyl-1-propanol. An example of *Nordstrom*'s definition of alkylene is presented in Compounds II and VII when the alkylene carbon atoms number from 1-4 (*Col 2 Lines 20-40*).] Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected any of the species of the genus of *Nordstrom*, including 3-cyclohexenyl-1-propanol.

The aromatic compounds of *Nordstrom* inherently possess an odor, and therefore, the addition of Compound I to the polymerization composition necessarily results in imparting some odor or fragrance to the polymerization composition.

The 3-cyclohexenyl alcohols in the Compound I genus are subsequently added to methacrylates which are also fragrant. Thus, it would also have been prima facie obvious that a methacrylate aroma would have been changed by the addition of the 3-cyclohexenyl-1-propanol because the two types of chemicals are prima facie, obviously different. When making these mixtures, *Nordstrom (Claim 1)* teaches a range within 0 to 99% of the genus that includes the Applicant's chemical.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Nordstrom (US 3536687)* in view of in view of *Tanigawa et al. (US 2002/0183564 Application 10/160356)* and further in view of *Palmer (US 6559118)*.

*Nordstrom (ibid)* teaches fabrication of a genus from which the Applicants' 3-cyclohexenyl-1-propanol is part. *Nordstrom (Col 4 Lines 1-24, Example 1)* also teaches an example showing that the resulting prepared chemical can be a mixture of Cyclohex-

3-enyl alcohol isomers. By doing so, *Nordstrom* (Example 3 Column 4 Lines 52-55) teaches the mixing of inherently fragrant alcohols.

*Nordstrom* fails to teach adding Compound (I) to “conventional constituents of a composition.”

On the other hand, *Tanigawa et al.* (Abstract) teaches that alicyclic unsaturated alcohols are useful for perfumes.

Additionally, *Palmer* (Abstract—when  $R_1$  is a methyl and  $R_6$ - $R_7$  are hydrogens, and claims 2-4) employs a genus of chemicals that includes at least one isomer of the Applicants’ claimed chemical for use in fragrance mixtures with other fragrance materials.

Therefore, it would have been obvious at the time the invention was made to have employed the Compound I described by *Nordstrom* in a perfume composition as suggested by *Palmer* and *Tanigawa* because compounds with similar structure will possess similar properties.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON GRESO whose telephone number is (571)270-7337. The examiner can normally be reached on M-F 0730-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/  
Supervisory Patent Examiner  
Art Unit 4131

AJG